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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,987	04/20/2001	Ronald S. Chamberlain	2026-4231US3	2855

7590 01/26/2004

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EXAMINER	
WILSON, MICHAEL C	

ART UNIT	PAPER NUMBER
1632	

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/838,987	CHAMBERLAIN ET AL.	
	Examiner	Art Unit	
	Michael C. Wilson	1632	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☐ For purposes of Appeal, the proposed amendment(s) a)☐ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-8,21 and 22*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

MICHAEL WILSON
PRIMARY EXAMINER

Continuation of 2. NOTE: the proposed limitation of "said antigen encoded by both of the first and second vector" in claims 21 and 22 would require a new 112/2nd rejection because the phrase lacks antecedent basis in claim 1 which requires an "antigen against which an immune response is desired".

Continuation of 5. does NOT place the application in condition for allowance because:

Applicants argue the specification describes using the method claimed to induce an immune response in a mammal, which is the one enabled use for the claimed method as required by law. Applicants' argument is not persuasive. Merely inducing an immune response in a mammal, in and of itself, does not have an enabled use by law because inducing an immune response is only described as being used to obtain a therapeutic or prophylactic effect. Therefore, inducing an immune response according to the specification must result in a therapeutic or prophylactic effect to have an enabled use. The pending claims remain rejected for reasons of record because the specification does not enable one of skill to induce a therapeutic or prophylactic immune response using the method as claimed.

Applicants argue the examiner has not provided motivation to administer two different vectors encoding the same antigen such that an immune response against the antigen occurs. Applicants' arugment is not persuasive. The examiner has accurately described the teachings of Wang and has provided adequate motivation to alter the teachings of Wang. One of ordinary skill would be motivated to administer vaccinia virus (VV) encoding beta-gal instead of administering wild-type VV, for example, to induce an immune response against beta-gal sooner, thus improving the immune response against beta-gal. Applicants argue the motivation is not adequate because it is not supported by the combined teachings, knowledge of one of ordinary skill in the art and the nature of the problem to be solved as a whole. Applicants' argument is not persuasive because Wang establishes the knowledge of one of ordinary skill in the art, i.e. an immune response against beta-gal can be induced using VV and FPV, and the nature of the problem to be solved, i.e. how to obtain the greatest immune response against beta-gal. Thus, the combined teachings, the knowledge of one of ordinary skill in the art and the ntaure of the problem to be solved are all established by Wang. Motivation to improve the immune response against beta-gal by replacing wild-type VV with VV-beta-gal is well within the teachings of Wang, the knowledge of one of ordinary skill in the art as established by Wang and the nature of the problem as established by Wang.

Applicants' arguments regarding 112/2nd are not persuasive because they are based on the proposed amendment that has not been entered. The pending claims remain rejected under 112/1st (enablement), 112/2nd and 103 for reasons of record.